



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,792	05/21/2001	Timothy L. Coyle	51181.00002	8927

7590 04/28/2004

SQUIRE, SANDERS & DEMPSEY L.L.P.
Two Renaissance Square
40 North Central Avenue, Suite 2700
Phoenix, AZ 85004-4498

EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
----------	--------------

3677

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No. 09/863,792	Applicant(s) COYLE, TIMOTHY L.	
	Examiner Ruth C Rodriguez	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Rosen et al. (US 6,493,677 B1) in view of Hoins (US 2002/0052811 A1) and Davies et al. (US 6,674,457 B1).

Von Rosen disclose a method for increasing sales of custom products (54) to niche markets. The method performed by one or more servers coupled to a network (Fig. 2). The method comprises: (a) communicating via the network with a customer (30) that provided a designation of a product (54) to be produced with an image (48) (Fig. 8A) and indicia of a first payment (Fig. 10B). von Rosen fails to disclose that the image is provided by a first member who receives an access code for the image and a designation of a beneficiary and of a first referrer. However, Davies teaches a method

on how to communicate an image from a source to another location through a telecommunications network. The method comprises: (a) communicating an access code from a server to the first member and then communicating in an audio telephone call the access code from the first member to a second member (customer); (b) providing an image from the first member to the server; and the second member (customer) can access the image from the server after providing the access code (when both servers are correlated (C. 2, L. 58-67 and C. 3, L. 1-23). The access code is used for purpose of security or billing purposes (C. 4, L. 53-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the steps of (a) communicating via a network with a first member to obtain an image; (b) providing exclusively to the first member an access code; (c) communicating via the network with a customer that provided the access code to obtain designation of the image as taught by Davies in the method disclosed by von Rosen where the first member will provide this access code to the customer in order to provide access to the image. Doing so, provides an access code to the first member for purposes of security or billing purposes. Regarding to the designating a beneficiary and distribution of portion of the first payment, Hoins teaches a method of designating a beneficiary and of distributing portions of a payment. The method comprises: (a) a first member communicates via a network with a server to designating a beneficiary (charitable organization) and providing a designation (to the charitable organization and to the first member) of a first referrer (first member) (Page 2, paragraph 27); (b) designating a distribution of portions of a payment to the beneficiary and to the first referrer (first

member) (Page 2, paragraph 30); (c) providing via the network to the first member a report describing portions paid to the referrer (Page 3, paragraph 0034); and (d) designating distribution to the first member of a portion of a second payment in accordance with a designation of a second referrer by a second member wherein the designation of the second referrer identifies the first member (Page 2, paragraph 30 and page 3, paragraphs 0034 and 0036). The method taught by Hoins motivates charitable contributions from members where these contributions are tax deductible and provides payments to the referrers for their referral services (Page 2, Paragraphs 0027 and 0030). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have the steps of: (a) communicating via a network with a first member to designating a beneficiary and providing a designation of a first referrer; (b) designating a distribution of portions of a payment to the beneficiary and to the first referrer; (c) providing via the network to the first member a report describing portions paid to the referrer; and (d) designating distribution to the first member of a portion of a second payment in accordance with a designation of a second referrer by a second member wherein the designation of the second referrer identifies the first member as taught by Hoins in the method disclosed by von Rosen and modified in accordance with Davies. Doing so, motivates charitable contributions from members where these contribution are tax deductible and provides payments to the referrers for their referral services.

The method taught by Hoins further comprises: (a) communicating via the network with the first member to obtain a designation of a payment term (paragraphs

0020, 0021 and 0022); and (b) designating distribution of portions of the first payment to the beneficiary in accordance with the payment term (paragraphs 0029,0034 and 0036).

Von Rosen, Davies and Hoins disclose the use of a memory device comprising instructions for the performance of the method by one or more servers.

Regarding claim 37 having almost the same limitations as claim 34, the rejection of claim 34 will also serve to reject claim 37 because claim 37 has the same limitations as claim 34 but it excludes the designation and distribution of a portion of the first payment to a first referrer and to a second referrer.

The method taught by Hoins further comprises: (a) communicating via the network with the first member to obtain a designation of a payment term (paragraphs 0020, 0021 and 0022); and (b) designating distribution of portions of the first payment to the beneficiary in accordance with the payment term (paragraphs 0029,0034 and 0036).

Von Rosen, Davies and Hoins disclose the use of a memory device comprising instructions for the performance of the method by one or more servers.

Von Rosen disclose a system coupled to a network that comprises means for communicating via the network with a customer (30) that provided a designation of a product (54) to be produced with an image (48) (Fig. 8A) and indicia of a first payment (Fig. 10B). von Rosen fails to disclose that the image is provided by a first member who receives an access code for the image and a designation of a beneficiary and of a first referrer. However, Davies teaches a system comprising means for communicating an image from a source to another location through a telecommunications network. The system comprises: (a) means for communicating an access code from a server to the

first member and then communicating in an audio telephone call the access code from the first member to a second member (customer); (b) means for providing an image from the first member to the server; and means for providing access to the image to the second member (customer) from the server after providing the access code (when both servers are correlated (C. 2, L. 58-67 and C. 3, L. 1-23). The access code is used for purpose of security or billing purposes (C. 4, L. 53-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a system having means for communicating via a network with a first member to obtain an image, means for providing exclusively to the first member an access code and means communicating via the network with a customer that provided the access code to obtain designation of the image as taught by Davies in the system disclosed by von Rosen where the first member will provide this access code to the customer in order to provide access to the image. Doing so, provides an access code to the first member for purposes of security or billing purposes. Regarding to the designating a beneficiary and distribution of portion of the first payment, Hoins teaches a system allowing the designating a beneficiary and of distributing portions of a payment. The system comprises: (a) means for communicating via the network with a first member to obtain a designation of a beneficiary (charitable organization) and providing a designation (to the charitable organization and to the first member) of a first referrer (first member) (Page 2, paragraph 27), means for designating a distribution of portions of a payment to the beneficiary and to the first referrer (first member) (Page 2, paragraph 30), means for providing via the network to the first member a report describing portions

paid to the referrer (Page 3, paragraph 0034) and means for designating distribution to the first member of a portion of a second payment in accordance with a designation of a second referrer by a second member wherein the designation of the second referrer identifies the first member (Page 2, paragraph 30 and page 3, paragraphs 0034 and 0036). The system taught by Hoins motivates charitable contributions from members where these contributions are tax deductible and provides payments to the referrers for their referral services (Page 2, Paragraphs 0027 and 0030). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have means for communicating via a network with a first member to designating a beneficiary and providing a designation of a first referrer, means for designating a distribution of portions of a payment to the beneficiary and to the first referrer, means for providing via the network to the first member a report describing portions paid to the referrer and means for designating distribution to the first member of a portion of a second payment in accordance with a designation of a second referrer by a second member wherein the designation of the second referrer identifies the first member as taught by Hoins in the system disclosed by von Rosen and modified in accordance with Davies. Doing so, motivates charitable contributions from members where these contribution are tax deductible and provides payments to the referrers for their referral services.

The system further comprising: means for communicating via the network with the first member to obtain a designation of a payment term (paragraphs 0020, 0021 and

0022); and means for designating distribution of portions of the first payment to the beneficiary in accordance with the payment term (paragraphs 0029,0034 and 0036).

Regarding claim 42 having almost the same limitations as claim 40, the rejection of claim 30 will also serve to reject claim 42 because claim 42 has the same limitations as claim 40 but it excludes the designation and distribution of a portion of the first payment to a first referrer and to a second referrer.

The system further comprises means for communicating via the network with the first member to obtain a designation of a payment term (paragraphs 0020, 0021 and 0022); and means for designating distribution of portions of the first payment to the beneficiary in accordance with the payment term (paragraphs 0029,0034 and 0036).

Response to Arguments

3. Applicant's arguments with respect to claims 34-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arledge, JR. et al. (US 6,535,294 B1), Kito (US 2002/0099565 A1), Sutherland et al (US 2002/0112001 A1) and Capozzi et al. (US 2003/0144923 A1) are cited to show state of the art with respect to a system that allows placing an image in a product through the Internet.

Batty et al. (US 2002/0107701 A1) is cited to show state of the art with respect to monitoring sale of a product through the Internet.

Pena (US 6,292,211 B1), Berger et al. (US 6,414,693 B1) and Yu (US 2002/0066095 A1) are cited to show state of the art with respect to utilizing a network to produce a personalized product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

Art Unit: 3677

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.


Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before and after final communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

RRR
rcr

April 19, 2004


JJ Swann
Supervisory Patent Examiner
Technology Center 3600